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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,243	02/01/2002	Bemel Goldberg	3715P2308CIP2	3596
23504	7590	06/21/2005	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			DUONG, OANH L.	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/066,243

Applicant(s)

GOLDBERG, BERNEL

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2002.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04/03/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-27 are presented for examination.

#### ***Drawings Objection***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "the customization settings are checked to detect customizations that have been performed (step 51). If a particular customization is found (decision 52) (and optionally if text is not present indicating the customization), a text string is generated describing the e-mail customization (step 53). Then, the user is prompted to present the option of inserting the text string into the message (subject line or message body) (step 54), otherwise the e-mail message is sent or saved in accordance with the user input in step 50" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.

MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show

the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 1, 10 and 19 are objected to because of the following informalities: the feature "may" should not be used in the claims.

Claims 1, 10 and 19 recites the limitation "the message" and "said message".

There are insufficient antecedent basis for this limitation in the claims.

Appropriate correction is required.

### ***Allowable Subject Matter***

3. Claims 6-7, 15-16 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 8, 10, 11, 17, 19-20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (US 2002/0107924 A1).

Regarding claim 1, Walsh teaches the invention substantially as claimed including a method for completing an e-mail transmission (Fig. 3 abstract), comprising:

receiving a user input indicating that an e-mail message is complete (page 2 paragraphs 22 and 27);

checking customization settings in the email message (page 2 paragraphs 21-24 24); and

in response to said checking detecting a particular customization setting, generating a user prompt to permit a user to automatically modify the email message (page 3 paragraph 33).

Walsh teaches the concept of determining customization settings, and accordingly generating a user prompt to automatically perform an action. Walsh's prompt allows the user to automatically attach a file to the email message or add additional people to an existing CC list. However, Walsh's prompt does not specifically teach modifying the text of the email message. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made that a prompt for an automatic action in Walsh may include a prompt modification of the text of the message if an indication of incomplete message is determined. Such modification in Walsh would enhance the functionality of Walsh's system allowing receiving a complete message by the recipient. In addition, modifying the text of email message is known in the art. For

example, Tsai (US 6,839,741) teaches in response to checking detecting a particular customization setting, modifying the text of the email message (col. 6 lines 29-30 and lines 64-66).

Regarding 10, a system of claims 10 performs a corresponding method of claim 1; therefore, claim 10 is rejected under the same rationale as applied to claim 1.

Regarding claim 19, a computer program product comprising program instructions for performing corresponding steps of claim 1; therefore, claim 20 is rejected under the same rationale as applied to claim 1.

Regarding claims 2, 11 and 20, Walsh teaches parsing said message to determine whether or not said user has already entered text that will notifying a recipient of a particular customization setting (page 2 paragraph 23); and in response to said parsing detecting said entered text, skipping said generating of said user prompt for said particular customization setting (i.e., if the result of the determination is negative, then only primary document is processed, page 2 paragraph 21).

Regarding claims 8, 17 and 26, Walsh teaches particular customization setting is a copy recipient list, and wherein said modification modifies said text to include a "cc:" list (page 4 paragraphs 36-38).

5. Claims 3-5, 12-14 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (US 2002/0107924 A1) in view of Chrabaszcz (US 6,073,133).

Regarding claims 3, 12 and 21, Walsh does not explicitly teach user input as claimed.

Chrabaszcz teaches the user input instructing an e-mail program to send the e-mail message (col. 2 lines 1-3 and col. 5 lines 29-34). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Walsh to include the user input instructing an email program to send the e-mail message as taught by Chrabaszcz because such user input would initiate a sequence of computer-readable instructions to be executed in order to ensure an electronic mail message is complete before the message is transmitted to recipients (Chrabaszcz, col. 1 lines 57-60).

Regarding claims 4, 13 and 22, Walsh-Chrabaszcz teaches said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to save said e-mail message (Chrabaszcz, col. 5 lines 29-34).

Regarding claims 5, 14 and 23, Walsh-Chrabaszcz teaches said user input indicating that said e-mail message is complete is a user input instructing an e-mail program to check said e-mail message (Chrabaszcz, col. 5 lines 29-34).

6. Claims 9, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (US 2002/0107924 A1) in view of Okumura et al. (Okumura) (US 2002/0049793 A1).

Regarding claims 9, 18 and 27, Walsh does not explicitly teach said modifying modifies a subject line of said message to include an indication of said level of urgency.

Okumura, in the same field of endeavor, teaches modifying a subject line of the email message (pages 4 paragraphs 75-85).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of Walsh to include modifying a subject line of the email message because it would enable an improper subject to be eliminated (Okumura, page 4 paragraph 88).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh Duong whose telephone number is (571) 272-3983. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D  
June 7, 2005

*Philip Tran*  
PHILIP TRAN (PSA)